

### **REMARKS**

The Office Action dated June 9, 2006, and the patents and publications relied on therein have been reviewed, and in view of the above changes and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

#### **Amendments To The Claims**

Assignee has amended claims 1, 4, 5, 8, 12, 13 and 17 to generally improve the respective forms of claims 1, 4, 5, 8, 12, 13 and 17 in accordance with U.S. patent law. In particular, the minor changes to claims 1, 4, 5, 8, 12, 13 and 17 are directed to formal matters and do not narrow the scope of the amended claims. Therefore, no prosecution-history estoppel results from the amendments.

#### **The Rejection Under 35 U.S.C. § 103(a) Over Cheung In View of Boll**

Claims 1, 2, 6-9, 13, 14, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cheung et al. (Cheung), U.S. Patent Application Publication No. 2003/0076550 A1, in view of Boll, U.S. Patent Application Publication No. 2003/0063333A1. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Assignee respectfully submits that the subject matter according to any of claims 1, 2, 6-9, 13, 14, 18 and 19 is patentable over Cheung in view of Boll. Assignee respectfully submits that a person of ordinary skill would be unable to produce the subject matter claimed in claims 1, 2, 6-9 even if both Cheung and Boll were before the person of ordinary skill. This is at least in part because, even if the cited documents are combined, without conceding that they may be properly combined, nonetheless, the combination would fail to provide all the elements or limitations of the rejected claims, such as, for example, claim 1. Moreover, it is likewise respectfully submitted that the applied documents are not properly combinable to form a basis for rejection of these claims.

Regarding claim 1, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest the claimed flexible member, disposed between the claimed top surface and the claimed limiting surface. The Examiner admits that Cheung does not disclose the claimed flexible member. (See Office Action dated June 9, 2006, page 2, line 24, through page 3, line 2.) Further, Assignee respectfully submits that Cheung does not suggest the claimed flexible member, otherwise the Examiner would not need to rely on Boll for providing the claimed flexible member.

Accordingly, Assignee respectfully submits that in order for the combination of Cheung and Boll to provide the claimed flexible member, Boll must provide the claimed flexible member. In this regard, the Examiner asserts that page 3, paragraph 32, of Boll discloses the claimed flexible member by stating that "Boll discloses a flexible member, disposed between the top surface and the limiting surface, wherein the optical scan module pushes the bottom surface of the transparent flat panel upward; the flexible member presses the top surface of the transparent flat panel downward accordingly." (See Office Action dated June 9, 2006, page 3, lines 3-6.) In actuality, paragraph 32 of Boll discloses a spring-loaded catch or detente mechanism similar to that employed in ball point pens that is used for retaining a light shield 64 in a light-obstructing position to block light from being directed upward from a light source 26 so that a transmissive object that is being scanned is completely back lit and there is no interfering reflections from the transmissive object that would otherwise degrade the scanned

image. (See Boll, paragraph 31.) Boll discloses nothing regarding the spring-loaded catch or detente mechanism pushing the bottom surface of the transparent flat panel upward such that the spring-loaded catch or detente mechanism presses the top surface of a transparent flat panel downward accordingly.

Regarding claim 2, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest the claimed optical scan module comprising a pushing device disposed on top of the optical scan module, such that the optical scan module pushes the transparent flat panel upward via the pushing device. Although the Examiner asserts that paragraph 32 of Boll "teaches wherein the optical scan module comprises a pushing device disposed on top of the optical scan module," Assignee respectfully submits that paragraph 32 of Boll in actuality discloses a rearward motion of a carriage 22 that causes a rear edge 74 of a shield actuator arm 72 of a light shield 64 to engage a fixed surface inside a housing 12, thereby shifting light shield 64 forward relative to carriage 22 to a light-obstructing position. Subsequent rearward movement of carriage 22 causes rear edge 74 of actuator arm 72 to again engage the fixed surface releasing the spring-loaded catch or detente mechanism and shifting the light shield to a non-obstructing position.

Regarding claim 8, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest the claimed flexible member for reasons that are similar to the reasons demonstrated above the neither Cheung nor Boll disclose or suggest the claimed flexible member of claim 1. More specifically, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest the claimed flexible member, located between a periphery of the top surface of the claimed transparent flat panel and a bottom wall surrounding the opening of the claimed top lid.

Regarding claim 9, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest that the claimed optical scan module for reasons that are similar to the reasons demonstrated above the neither Cheung nor Boll disclose or suggest the claimed flexible member of claim 2.

Regarding claim 13, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest a distance between the claimed supporting surface and the claimed limiting surface is

slightly larger than a thickness of the claimed transparent flat panel to allow the transparent flat panel to move vertically, and the optical scan module is allowed to push the bottom surface of the transparent flat panel upward. Both Cheung and Boll are simply silent in this regard.

Regarding claim 14, Assignee respectfully submits that neither Cheung nor Boll disclose or suggest that the claimed optical scan module for reasons that are similar to the reasons demonstrated above the neither Cheung nor Boll disclose or suggest the claimed flexible member of claim 2.

Regarding the Examiner's proffered motivation for combining Cheung and Boll, Assignee respectfully submits that contrary to the Examiner's statement, there simply is no suggestion in either Cheung or Boll to "to combine Boll with Cheung by incorporating a spring-loaded catch" "to retain the shield in the (second) position, as taught by Boll." (See Office Action dated June 9, 2006, page 3, lines 9-12.) Assignee respectfully submits that Cheung discloses nothing about a light shield that can be positioned in a light-obstructing position to block light from being directed upward from a light source so that a transmissive object that is being scanned is completely back lit and there is no interfering reflections from the transmissive object that would otherwise degrade the scanned image. Furthermore, the Examiner has not indicated how the spring-loaded catch disclosed by Boll would be incorporated into the Cheung device to retain a shield for which Cheung provides no disclosure.

Thus, Assignee respectfully submits that it is only by impermissible hindsight that the Examiner is able to reject claims 1, 2, 6-9, 13, 14, 18 and 19 based on the proffered combination. Neither of the applied patents provides a proper suggestion for combination, and even if they did, the device resulting from the proffered combination is simply not the claimed invention. It is only by the Assignee's disclosure that the Examiner can select particular features of Cheung and Boll to make the rejection.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection.

**The Rejection Under 35 U.S.C. § 103(a) Over Cheung And Boll In View of Tsai**

Claims 3, 10 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cheung and Boll in view of Tsai et al. (Tsai), U.S. Patent No. 6,678,075. This rejection is respectfully traversed.

Assignee respectfully submits that the subject matter of claims 3, 10 and 15 is patentable over Cheung and Boll in view of Tsai because Tsai does not cure the deficiencies of Cheung and Boll with respect to claims 1, 8 and 13, the respective base claims of claims 3, 10 and 15. Specifically, Tsai does not provide the limitations of the claimed subject matter lacking in Cheung and Boll, and Tsai does not provide a proper suggestion for the combination of Cheung and Boll.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection.

**The Rejection Under 35 U.S.C. § 103(a) Over Cheung And Boll In View of Hsu**

Claims 5, 12 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cheung and Boll in view of Hsu, U.S. Patent Application Publication No. 2003/0058488 A1. This rejection is respectfully traversed.

Assignee respectfully submits that the subject matter of claims 5, 12 and 17 is patentable over Cheung and Boll in view of Hsu because Hsu does not cure the deficiencies of Cheung and Boll with respect to claims 1, 8 and 13, the respective base claims of claims 5, 12 and 17. Specifically, Hsu does not provide the limitations of the claimed subject matter lacking in Cheung and Boll, and Hsu does not provide a proper suggestion for the combination of Cheung and Boll.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection.

**The Rejection Under 35 U.S.C. § 102(b) Over Hsu**

Claims 1-19 stands rejected under 35 U.S.C. § 102(b) as anticipated by Hsu. This rejection is respectfully traversed.

Assignee respectfully submits that the subject matter of any of claims 1-19 is not anticipated by Hsu.

Regarding claim 1, Assignee respectfully submits that Hsu does not disclose the claimed a supporting member, located on a surface of the top lid, such that the claimed supporting member comprises a supporting surface which is in contact with a periphery of the bottom surface of the transparent flat panel. While Figure 7 of Hsu illustrates the interaction of supporting groove 1510 and a linking bar 1600, Hsu is notably silent regarding the Examiner assertion that "a supporting member 1510, located on a surface which is in contact with a periphery of the bottom surface of the transparent flat panel." Assignee respectfully submits that, at best, Hsu supporting groove 1510 is in contact with a periphery of the Hsu top lid 1100.

Further, Assignee respectfully submits that Hsu does not disclose the claimed limiting member that is located on the surface of the top lid, such that the limiting member comprises a limiting surface disposed on a periphery of the top surface of the transparent flat panel. Instead, Hsu discloses a spring-loaded lock 1700 that is disposed on a periphery of the Hsu top lid 1100.

Further still, Assignee respectfully submits that the Examiner has not shown with specificity where Hsu discloses the claimed optical scan module that pushes the bottom surface of the transparent flat panel upward. The Examiner merely asserts that Hsu provides such a limitation.

Claims 2-7, which each incorporate the limitations of claim 1, are each not anticipated by Hsu for at least the same reasons that claim 1 is considered to not be anticipated by Hsu.

Regarding claim 2, Assignee respectfully submits that claim 2 is not anticipated by Hsu for the additional reason that Hsu does not disclose the claimed optical scan module that comprises a pushing device disposed on top of the optical scan module. Hsu is silent in this regard.

Claims 3-5 are not anticipated by Hsu for at least the same reasons that claim 2 is considered to not be anticipated by Hsu. Claim 3 is not anticipated by Hsu for the additional reason that Hsu does not disclose the claimed pushing device that slides under the bottom surface of the transparent flat panel. Claim 4 is not anticipated by Hsu for the additional reason that Hsu

does not disclose the claimed pushing device that rolls horizontally under the bottom surface of the transparent flat panel. Claim 5 is not anticipated by Hsu for the additional reason that Hsu does not disclose that the claimed transparent flat panel extends to a region beyond the opening, while the moving area of the pushing device includes a part of the region beyond the opening. For each of claims 3-5, Hsu is silent regarding the claimed pushing device.

Regarding claim 8, Assignee respectfully submits that Hsu does not disclose an optical scan module that pushes the bottom surface of the claimed transparent flat panel upward. Hsu is silent in this regard.

Claims 9-12, which each incorporate the limitations of claim 8, are each not anticipated by Hsu for at least the same reasons that claim 8 is considered to not be anticipated by Hsu.

Claim 9 is not anticipated by Hsu for the additional reason that Hsu does not disclose that the optical scan module comprises a pushing device disposed on top of the optical scan module, such that the optical scan module pushes the transparent flat panel upward via the pushing device. Hsu is silent regarding a pushing device.

Claims 10-12 are not anticipated by Hsu for at least the same reasons that claim 12 is considered to not be anticipated by Hsu. Each of claims 10-12 is not anticipated by Hsu for the additional reason that Hsu does not disclose the claimed pushing device.

Assignee respectfully submits that claim 13 is not anticipated by Hsu because Hsu does not disclose the claimed supporting member, located on a surface of the top lid, such that the supporting member comprises a supporting surface which is in contact with a periphery of the bottom surface of the transparent flat panel. As demonstrated in connection with claim 1, Hsu supporting groove 1510 is in contact with a periphery of the Hsu top lid 1100.

Further regarding claim 13, Assignee respectfully submits that Hsu does not disclose the claimed limiting member, located on the surface of the top lid, such that the limiting member comprises a limiting surface disposed on a periphery of the top surface of the transparent flat panel. Instead, Hsu discloses a spring-loaded lock 1700 that is disposed on a periphery of the Hsu top lid 1100.

Lastly regarding claim 13, Hsu does not disclose a distance between the claimed supporting surface and the claimed limiting surface is slightly larger than a thickness of the claimed transparent flat panel to allow the transparent flat panel to move vertically, and the optical scan module is allowed to push the bottom surface of the transparent flat panel upward. Hsu is silent in this regard.

Claims 14-19, which each incorporate the limitations of claim 13, are each not anticipated by Hsu for at least the same reasons that claim 13 is considered not to be anticipated by Hsu.

Claim 14 is not anticipated by Hsu for the additional reason that Hsu does not disclose the claimed optical scan module that comprises a pushing device disposed on top of the optical scan module, such that the optical scan module pushes the transparent flat panel upward via the pushing device. Hsu is silent in this regard.

Claims 15-17 are not anticipated by Hsu for at least the same reasons that claim 14 is considered to not be anticipated by Hsu. Each of claims 15-17 is not anticipated by Hsu for the additional reason that Hsu does not disclose the claimed pushing device.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection.

### **Newly Added Claims**

Assignee respectfully requests that the Examiner enter claims 20-69. Support for these claims can be found at least in the originally filed claims 1-19. In particular, support for new claims 20-39 can at least respectively be found in originally filed claims 1-19. Support for new claims 40-59 can at least respectively be found in originally filed claims 1-19. Support for new claims 60-64 can at least respectively be found in originally filed claims 1-4. Support for new claims 65-69 can at least respectively be found in originally filed claims 8-11.

Assignee respectfully submits that each of new claims 20-69 are allowable for at least the reasons that their corresponding support claims are considered allowable.



Assignee notes that additional patentable distinctions between the applied patents and published patent application and the rejected claims exist; however, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

### CONCLUSION

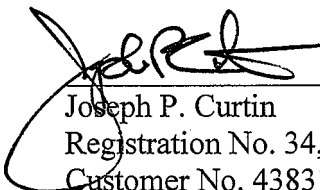
In view of the above amendments and arguments, it is urged that the present application is now in condition for allowance. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

A general authorization under 37 C.F.R. § 1.25(b), second sentence, is hereby given to credit or debit Deposit Account No. 50-3703 for the instant filing and for any other fees during the pendency of this application under 37 C.F.R. §§ 1.16, 1.17 and 1.18.

It is requested that this application be passed to issue with claims 1-69.

Respectfully submitted,

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